



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:
Werner POECHMULLER et al.

For: DEVICE FOR DATA RECEPTION VIA
RADIO SIGNALS IN A MOTOR
VEHICLE

Filed: December 21, 2001

Serial No.: 10/026,087

Examiner: Amare Mengistu

Art Unit: 2673

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APPEAL BRIEF TRANSMITTAL

SIR:

Transmitted herewith for filing in the above-identified patent application,
please find an Appeal Brief pursuant to 37 C.F.R. § 41.27

Please charge the Appeal Brief fee of \$500.00, and any other fees that may
be required in connection with this communication to the deposit account of **Kenyon &
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Applicants hereby request a five-month extension of time for submitting
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Respectfully submitted,

Dated: October 23, 2006

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[10191/2132]

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Chih Lin

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

SIR:

On March 20, 2006, Appellants submitted a Notice of Appeal from the last decision of the Examiner contained in the Final Office Action dated September 19, 2005 in the above-identified patent application. The Notice of Appeal is believed to have been received by the United States Patent and Trademark Office on March 23, 2006.

In accordance with 37 C.F.R. § 41.37, this brief is submitted in support of the appeal of the final rejections of claims 1 to 11, and 13 to 16. For at least the reasons set forth below, the final rejections of claims 1 to 11, and 13 to 16 should be reversed.

1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Federal Republic of Germany, which is the assignee of the entire right, title and interest in the present application.

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2. RELATED APPEALS AND INTERFERENCES

There are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, Robert Bosch GmbH, “which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.”

3. STATUS OF CLAIMS

Claim 12 has been canceled.

Claims 1 to 11, and 13 to 16 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,779,196 (“Igbinadolor”) and U.S. Patent No. 5,588,046 (“Knuth et al.”).

Appellants appeal from the final rejections of claims 1 to 11, and 13 to 16.

A copy of the appeal claims, *i.e.*, claims 1 to 11, and 13 to 16, is attached hereto in the Claims Appendix.

4. STATUS OF AMENDMENTS

In response to the Final Office Action dated September 19, 2005, Appellants filed a “Reply Under 37 C.F.R. § 1.116” on January 23, 2006. However, the Reply did not include any proposed amendments to the claims or other amendments to the application.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present application relates to a device for receiving data via radio signals in a motor vehicle. *Specification*, page 1, lines 7 to 8. Fig. 1 shows an example of the device as a block diagram. *Specification*, page 4, line 17. For receiving data, the device may include an antenna 5 and a high-frequency slave station 4 designed for receiving broadband digital radio signals. *Specification*, page 5, lines 5 to 7. A processor 3 may process the data and bring the data for playback on display 7, which may display the processed data. *Specification*, page 5, lines 9 to 14. The device may include a memory 24 in which a defined state may be stored. *Specification*, page 5, line 30. The device may also include an input device 1, which, when operated once, in the event of a fault may put the device in the defined state for playing back the data. *Specification*, page 1, lines 8 to 11, and page 5, line 30 to page 6, line 31. The fault may include a failure of a service to respond, a failure in data reception, a lack of device compatibility, a software fault, an operating system fault, and/or a memory fault. *Specification*, page 1, lines 16 to 20.

6. **GROUND OF REJECTIONS TO BE REVIEWED ON APPEAL**

Whether claims 1 to 11, and 13 to 16, which stand rejected under 35 U.S.C. § 103(a), are patentable over the combination of Igbinadolor and Knuth et al.

7. **ARGUMENTS**

Rejection of Claims 1 to 11, and 13 to 16 Under 35 U.S.C. § 103(a)

i. **Claims 1 to 5, and 13 to 15**

Claims 1 to 5, and 13 to 15 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Igbinadolor and Knuth et al. It is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable any of claims 1 to 5, and 13 to 15 for at least the following reasons.

Claim 1 relates to a device for receiving data via radio signals in a motor vehicle, and recites a radio receiver for receiving data and an input device that, when operated once in the event of a fault, puts the device in a state defined in a memory for playing back the data.

Establishment of *prima facie* obviousness requires satisfaction of three separate criteria. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the proposed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). The reasonable expectation of success must be found in the prior art, and must not be based on applicant's disclosure. *In re Vaeck, supra*. Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Examiner admits that Igbinadolor does not disclose an “input device [that] when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data,” but instead refers to Knuth et al., at column 4, lines 38 to 58, and column 6, lines 55 to 67, as allegedly disclosing these features. Knuth et al. provide for a telephone answering device that includes an audio random access memory chip, which is repeatedly checked to determine whether there is sufficient memory to record an outgoing message (OGM). If an OGM record key is pressed, the device enters from a RAM CHECK state to an OGM RECORD state, but if it is determined that there is not sufficient memory, the device returns to the RAM CHECK STATE without allowing for a recording of the

OGM. The referenced sections of Knuth et al. do not disclose or suggest an input device that when operated in the event of a fault puts a device into a state for playing back data. Accordingly, even if the system of Igbinadolor is modified to include the features of the digital telephone answering device and the memory testing method of Knuth et al., the modified system would still not disclose or suggest all of the features recited in claim 1.

Furthermore, as for the requirement that the references must provide a suggestion or motivation for making the proposed combination, the present rejection is plainly deficient. The Examiner does not provide any indication whatsoever of a suggestion or motivation by Igbinadolor or Knuth et al. to make the proposed combination. Merely because certain references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). If the desirability of the combination cannot be found in the prior art, then a rationale must be provided that is reasoned from knowledge generally available to one of ordinary skill in the art, based on established scientific principles, or based on legal precedent established by prior case law. *See* M.P.E.P. § 2144. At least a convincing line of reasoning must be presented to support the rejection. *Ex Parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985).

The Examiner asserts that it would have been obvious to modify the system of Igbinadolor to include the features discussed by Knuth et al. “because this will replay or recover the information which has been missed during malfunction.” However, incorporating the features of the method of Knuth et al. of exiting a recording state in response to a detection of insufficient memory, does not provide for replaying or recovering “information which has been missed during malfunction.” Thus, the Examiner has not provided any convincing line of reasoning for making the proposed combination. Therefore, the present rejection is plainly deficient with respect to the requirement to provide a suggestion or motivation to make the proposed combination. As such, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection.

Since the combination of Igbinadolor and Knuth et al. does not disclose or suggest all of the features recited in claim 1, and since there is no motivation or suggestion to make the proposed combination, the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 1.

As for claims 2 to 5, and 13 to 15, which depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination

of Igbinadolor and Knuth et al. does not render unpatentable these dependent claims for at least the same reasons set forth above in support of the patentability of claim 1. *In re Fine, supra* (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of all of the foregoing, reversal of this rejection is respectfully requested.

ii. Claims 6 to 10

Claims 6 to 10 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Igbinadolor and Knuth et al. It is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable any of claims 6 to 10 for at least the following reasons.

Claim 6 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable this dependent claim for at least the same reasons set forth above in support of the patentability of claim 1. *Id.*

Furthermore, claim 6 recites that the input device, when operated in the event of a fault, puts the device in a state that leads to a display of selection options including a first selection option to resume data reception from a service, a second selection option to resume a service used previously, a third selection option to return to a selected portal of a service provider, and a fourth selection option to restart the device. The Examiner asserts that each of these options is disclosed or suggested by the system of Igbinadolor, or that the system of Igbinadolor “should have to have” the options. Final Office Action, pages 3 to 4. Even if Igbinadolor does disclose or suggest each of these options, which Appellants do not concede, the combination of Igbinadolor and Knuth et al. does not disclose or suggest an input device that, when operated in the event of a fault, puts a device in a state that leads to a display of these selection options. For this additional reason, it is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 6.

As for claims 7 to 10, which depend from claim 6 and therefore include all of the features recited in claim 6, it is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable these dependent claims for at least the same reasons set forth above in support of the patentability of claim 6. *In re Fine, supra.*

In view of all of the foregoing, reversal of this rejection is respectfully requested.

iii. Claim 11

Claim 11 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Igbinadolor and Knuth et al. It is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 11 for at least the following reasons.

Claim 11 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable this dependent claim for at least the same reasons set forth above in support of the patentability of claim 1. *Id.*

Furthermore, claim 11 recites that the input device includes a pushbutton that causes various states of the device after operation for different periods of time. The Examiner refers to column 5, lines 3 to 57 of Igbinadolor as allegedly disclosing or suggesting these features. However, the referenced section does not refer to operation of a button for different periods of time or causing various states after such operation. For this additional reason, it is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 11.

In view of all of the foregoing, reversal of this rejection is respectfully requested.

iv. Claim 16

Claim 16 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Igbinadolor and Knuth et al. It is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 16 for at least the following reasons.

Claim 16 depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable this dependent claim for at least the same reasons set forth above in support of the patentability of claim 1. *In re Fine, supra.*

Furthermore, claim 16 recites that a processor is configured to perform decoding and reformatting of the data. The Examiner refers to Fig. 3A and column 6, lines 47 to 54, column 7, lines 7 to 14, and column 7, line 65 to column 8, line 7 of Knuth et al. as allegedly disclosing or suggesting these features. However, while the referenced sections may refer to decoding and processing an event, nowhere do Knuth et al. disclose or suggest decoding data, for playback of which a state is defined in a memory, and, in particular, where

a device is put into the state by an input device when the input device is operated in the event of a fault. Furthermore, the referenced sections do not disclose or suggest reformatting the data. For these additional reasons, it is respectfully submitted that the combination of Igbinadolor and Knuth et al. does not render unpatentable claim 16.

In view of all of the foregoing, reversal of this rejection is respectfully requested.

8. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellants in the appeal. An “Evidence Appendix” is nevertheless attached hereto.

9. RELATED PROCEEDINGS APPENDIX

As indicated above in Section 2, above, “[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, Robert Bosch GmbH, ‘which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.’” As such, there are no “decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]” to be submitted. A “Related Proceedings Appendix” is nevertheless attached hereto.

10. CONCLUSION

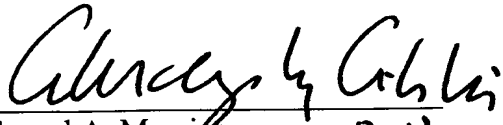
For at least the reasons indicated above, Appellants respectfully submit that the art of record does not disclose or suggest the subject matter as recited in the claims of the above-identified application. Accordingly, it is respectfully submitted that the subject matter recited in the claims of the present application is new, non-obvious and useful.

In view of all of the foregoing, reversal of all of the rejections set forth in the Final Office Action is therefore respectfully requested.

Respectfully submitted,

Dated: October 23, 2006

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CLAIMS APPENDIX

1. A device for receiving data via radio signals in a motor vehicle, comprising:
an input device;
a radio receiver for receiving data;
a processor for processing the data;
a memory; and
a display for displaying the processed data,
wherein the input device, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, and
wherein the fault includes at least one of a failure of a service to respond, a failure in data reception, lack of device compatibility, a software fault, an operating system fault, and a memory fault.
2. The device according to claim 1, wherein the input device includes at least one pushbutton on the device.
3. The device according to claim 1, wherein the input device includes a remote control.
4. The device according to claim 1, wherein the input device includes a microphone.
5. The device according to claim 1, wherein the state leads to the display of selection options, one of which is to be selected.
6. The device according to claim 5, wherein the selection options include:
a first selection option to resume data reception from a service;
a second selection option to resume a service used previously;
a third selection option to return to a selected portal of a service provider; and
a fourth selection option to restart the device.
7. The device according to claim 6, wherein the portal is stipulated by a user of the device.
8. The device according to claim 6, wherein the portal is stipulated in the device.

9. The device according to claim 6, wherein the restart is performed through software.
10. The device according to claim 6, wherein the restart is performed through hardware.
11. The device according to claim 2, wherein the pushbutton causes various states of the device after operation for different periods of time.
13. The device according to claim 1, wherein the radio signals include at least one of Digital Audio Broadcasting signals, Digital Video Broadcasting signals, and Digital Radio Mondial signals.
14. The device according to claim 1, wherein the data includes at least one of a web page, a video data stream, an image, a graphic, text, and animation.
15. The device according to claim 1, wherein the input device includes an infrared transceiver device.
16. The device according to claim 1, wherein the processor is configured to perform decoding and reformatting of the data.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§1.130, 1.131, or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellants in the appeal.

RELATED PROCEEDINGS APPENDIX

As indicated above in Section 2 of this Appeal Brief, “[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, Robert Bosch GmbH, ‘which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.’” As such, there no “decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]” to be submitted.